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**UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA**

LIFESCAN, INC. and
 LIFESCAN SCOTLAND, LTD.,
 Plaintiffs,
 v.

SHASTA TECHNOLOGIES, LLC,
 DECISION DIAGNOSTICS CORP.,
 PHARMATECH SOLUTIONS, INC., and
 CONDUCTIVE TECHNOLOGIES, INC.,
 Defendants.

Case No. CV11-04494-WHO

**JOINT STATEMENT REGARDING
 STAYING CAUSES OF ACTION**

(DKT. NO. 370)

Pursuant to the Court's Order dated October 1, 2013 (Dkt No.370), all parties submit the following Joint Statement setting forth which causes of action in both this action (the "11-cv-04494 action") and *LifeScan, Inc. et al. v. Shasta Technologies, LLC, et al.*, Case N. 12-cv-6360 (N.D. Cal.) (the "12-cv-6360 action"), are currently stayed, which causes of action the parties agree to stay and which causes of action the parties do not agree to stay:

A. Causes of Action That Are Currently Stayed

In the 11-cv-04494 action: By Order dated March 19, 2013, this Court stayed this case as two of the patents asserted by Plaintiffs, *i.e.*, U.S. Patent Nos. 5,708,247 (the "'247 Patent") and 6,241,862 (the "'862 Patent"), pending reexamination of those patents. Dkt. No. 245. Pursuant to that Order, Count I of the First Amended Complaint (for infringement of the '247 Patent (Dkt. No. 170¹ ¶¶ 42-47)) is currently stayed pending final exhaustion of the patent reexamination proceedings for the '247 Patent, including any appeals, and Count II of the First Amended Complaint (for infringement of the '862 patent (Dkt. No. 170 ¶¶ 48-53)) is currently stayed pending final exhaustion of the patent reexamination proceedings for the '862 Patent, including any appeals. *See* Dkt. No. 245.

Additionally, on May 6, 2013, pursuant to a stipulation between the parties, the Court stayed proceedings on damages, willfulness, and on Defendants' antitrust defenses and counterclaims (Defendant PharmaTech Solutions, Inc.'s and Decision Diagnostics Corp.'s First and Second Claim for Relief (Dkt No. 346 ¶¶ 55-69) and Shasta Technologies, LLC's and Conductive Technologies, Inc.'s First and Second Cause of Action (Dkt. No. 265 ¶¶ 47-61)), and bifurcated those issues from liability issues concerning all patents-in-suit. *See* Dkt No. 294.

In the 12-cv-6360 action: No causes of action are currently stayed.

B. Causes of Action the Parties Agree to Stay

In the 11-cv-04494 action: The parties agree that the following causes of action should be stayed pending a final decision by the Patent Trials and Appeals Board ("PTAB") in the pending *inter partes* review ("IPR") relating to U.S. Patent No. 7,250,105 (the "'105 patent"):

(1) Count III of the First Amended Complaint (infringement of the '105 patent (Dkt. No. 170 ¶¶

¹ Unless otherwise noted, docket entries refer to the 11-cv-04494 action.

54-60)); and (2) Defendants' PharmaTech and Decision Diagnostics Third through Sixth Claims for Relief (Dkt. No. 346 ¶¶ 70-96). The parties further agree that when the PTAB issues a final decision in the IPR of the '105 Patent, the Court, on the request of any party, may consider whether the stay discussed in this paragraph should, or should not, continue during the pendency of any appeals from that final decision.

In the 12-cv-6360 action: The parties agree that Plaintiffs' First, Fifth and Sixth Claims for Relief, to the extent they do not relate to Defendants' use of Plaintiffs' trademarks and trade dress (as described further in Section C below), should be stayed pending a final decision by the PTAB in the pending IPR relating to the '105 patent. The parties further agree that when the PTAB issues a final decision in the IPR of the '105 Patent, the Court, on the request of any party, may consider whether the stay discussed in this paragraph should, or should not, continue during the pendency of any appeals from that final decision.

C. Causes of Action the Parties Do Not Agree to Stay

In the 11-cv-04494 action: Except as discussed below, the parties agree that all causes of action that are not already subject to a stay in this action should be stayed pending a final decision by the PTAB in the IPR relating to the '105 patent.

In the 12-cv-6360 action: The parties do not agree to a stay of the following causes of action:

- 1) Plaintiffs' Second and Third Claims for Relief. (Dkt. No. 1 in the 12-cv-6360 action at ¶¶ 97-109).
- 2) Plaintiffs' First, Fifth, and Sixth Claims for Relief, insofar as they relate to Defendants' use of Plaintiffs' trademarks and trade dress (described in the Complaint at paragraphs 52-67). (*See* Dkt. No. 1 in the 12-cv-6360 action.)²

D. Pending Motions

In the 11-cv-04494 action, the parties agree that certain pending motions should not be stayed:

² There is no cause of action titled "Fourth Claim for Relief" in the Complaint in the 12-cv-6360 action.

1) The Order to Show Cause why LifeScan should not be held in contempt. Dkt. No. 336.

2) LifeScan's Motion to Modify the Protective Order. Dkt. No. 368.

E. Pending Preliminary Injunction Appeal

In the 11-cv-04494 action: Defendants have appealed to the U.S. Court of Appeals from the grant of a preliminary injunction in this case based on the '105 patent. Dkt. No. 246. The parties agree that if the Federal Circuit affirms this Court's grant of a preliminary injunction, the Court should, on the request of any party, consider whether the stay in this case that is discussed in Section (B) above should, or should not, extend to proceedings to enforce the preliminary injunction.

Dated: October 4, 2013

/s/ Gregory L. Diskant
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/s/ John J. Shaeffer
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 Attorneys for Defendants Decision Diagnostics
 Corp. and Pharmatech Solutions, Inc.

1 I hereby attest that I have on file written permission to sign this stipulation from all parties
2 whose signatures are indicated by a "conformed" signature (/s/) within this e-filed document.

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4 /s/ Eugene M. Gelernter
Eugene M. Gelernter
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